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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/689,510 | 10/21/2003 | Eugenio Cruz Garcia | 5724.017.23.US | 8656 |

30827 7590 01/17/2007
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| EXAMINER |
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CHAPMAN, JEANETTE E

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| ART UNIT | PAPER NUMBER |
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3635

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/689,510

Applicant(s)

GARCIA ET AL.

Examiner

Chapman E. Jeanette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10-12, 14-18, 25-27, 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Thiers (6786019).

Thiers discloses a flooring system comprising:

1. at least two planks adjacent each other along a predetermined direction; Figure 1
2. each plank comprises:
 - a. a plurality of sides defining a perimeter
 - b. a plurality of edge patterns 15 arranged proximate at least a first portion of the perimeter; safely assumed is that the plurality of edge patterns are substantially identical since the drawing do not show a contrasting color or shade
 - c. A first portion $\frac{5}{6}$ of the perimeter and a second portion $\frac{3}{4}$ of the perimeter
 - d. at least one bulk pattern/surface adjacent the plurality of edge patterns and proximate at least one second portion of the perimeter
 - e. the at least one bulk pattern an adjacent edge pattern form a continuous pattern as shown in the drawing figure 1
 - f. the edge patterns of at least two planks form a continuous pattern
 - g. the edge patterns include a decorative motif; see column 3, lines 15-22

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- h. the bulk and edge patterns comprises a decorative motif; see column 8, line 16 through column 9, line 10 and column 3, lines 10-25
- i. the first and second portion of the perimeter constitute the perimeter
- j. at least one edge portion 26 are formed on the at least one first portion of the perimeter
- k. at least one edge portion extends away from the perimeter by a predetermined distance; see figures 7-10
- l. at least one edge pattern extends along at least a portion of and along an entirety of the plurality of sides; see figures 2-4
- m. the decorative motif comprises at least two edge patterns adjacent each of the sides of the panel and at least one bulk pattern in the interior of the panel
- n. a tongue 8 extending from the perimeter of one edge and a groove 9 running along the perimeter of the opposite edge of each plank, wherein any one of the grooves is capable of receiving any of the tongues
- o. the planks are arranged in a direction such that the tongue of one plank fits into the groove of an adjacent plank

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9, 13, 19-24, 28 and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiers in view of Piacente(5858160). Thiers discloses various forms of decorative motive but lacks the embossed surface decorative motif. Piacente discloses teaches the embossed surface texture and suggest a continuous pattern on flooring tiles. Piacente teaches an embossed in register pattern in laids with peaks and valleys. Se column 9, lines 10-22. it would have been obvious to include an out of registration decorative motif because Thiers already suggest such with the veneers and the print and the two would be easier to create if they did not have to be aligned in a continuous pattern. In view of the above, it would have been obvious to include an embossed surface decorative motif in order to impart an actual wood grain to the flooring panels.

For claims 13, 28 and 41: the distance the edge pattern extends is dependent on the designed not the overall function of the plank; one of ordinary skill in the art would have appreciated extending the edge pattern according to the appearance to be assumed b the flooring panel.

Regarding claim 33, Thiers suggest many variations in decorative motifs; in view of this suggested variation, the combination and types of designs imparted to the flooring panels are endless. One of ordinary skill in the art would have appreciated using any creative idea according to desired aesthetic appeal to make any number of designs including making at least one portion of the decorative motif along a side different from the corresponding portion of the motif along a second opposite side.

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Nevertheless, Piacente teaches two different patterns on a flooring panel. Again, it would have been obvious to one of ordinary skill in the art to make a variety of patterns with the tile laminates as taught by Piacente to provide a pattern needed for any color scheme and any motif desired.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAKO SLACK can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JEANETTE CHAPMAN
PRIMARY PATENT EXAMINER
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